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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,739	01/04/2001	James L. Kroening	97-0506 D1.1	2734
23531	7590	09/13/2004	EXAMINER	
SUITER WEST PC LLO 14301 FNB PARKWAY SUITE 220 OMAHA, NE 68154			ROCHE, TRENTON J	
			ART UNIT	PAPER NUMBER
			2124	

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/754,739	KROENING ET AL.
	Examiner	Art Unit
	Trent J Roche	2124

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 29 June 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 24-46 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 24-46 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 04 January 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

1. This office action is responsive to Amendment A filed 29 June 2004.
2. Per applicant's request, claims 1-23 have been canceled. Newly added claims 24-46 have been entered.
3. Claims 24-46 have been examined.

Claim Rejections - 35 USC § 101

4. The rejections of claims 20-23 under 35 U.S.C. § 101 have been withdrawn due to the cancellation of claims 20-23 by the applicant.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claim 43 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claim 43 recites the limitation "the first information handling system" in line 3. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination this will be interpreted to read "a first information handling system."

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 24-46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,775,829. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to substantially the same invention and recite only obvious differences which would have been obvious to one of ordinary skill in the art at the time the invention was made such as (i) system implementation of the method, and/or (ii) implementing removable storage medium readable by an information handling system, as explained below.

The corresponding claims are as follows

Instant claim:

24	1
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Patent 6,775,829 claim:

37	14
38	15
39	16
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42	19
43	21
44	22
45	23
46	20

Per claim 24:

Patent 6,775,829	Instant Application
1. A computer implemented method of building a custom software configuration, comprising:	24. A system for building a custom software configuration, comprising:
Receiving a plurality of requests for desired software configurations;	An order entry system for receiving a plurality of requests for desired software configurations;
Identifying at least one baseline configuration corresponding to the desired software configurations;	An image builder for identifying at least one baseline configuration corresponding to the desired software configurations;
Comparing the at least one baseline configuration with the desired software configurations;	Comparing the at least one baseline configuration with the desired software configurations;
Creating a set of changes based on the comparison wherein the set of changes are suitable for combining with the baseline configuration to generate the desired software configuration	Creating a set of changes based on the comparison wherein the set of changes are suitable for combining with the baseline configuration to generate the desired software configuration
Storing the at least one baseline configuration and set of changes on a removable medium, the removable medium suitable for loading a plurality of desired software configurations corresponding to the requested plurality of desired software configurations.	An image server for storing the at least one baseline configuration and set of changes on a removable medium, the removable medium suitable for loading a plurality of desired software configurations corresponding to the requested plurality of desired software configurations.

The instant claim recites a system, including an order entry system, an image builder, and an image server corresponding to the patented method as set forth above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the patented method in a system for the purpose of enabling a computer to perform the steps of the patented method.

Per claim 29:

Patent 6,775,829	Instant Application
6. A computer implemented method of building a custom software configuration, comprising: Receiving a first request for a first desired software configuration and a second request for a second desired software configuration, the first desired software configuration being different than the second desired software configuration;	29. A system for building a custom software configuration, comprising: An order entry system for receiving a first request for a first desired software configuration and a second request for a second desired software configuration, the first desired software configuration being different than the second desired software configuration;
Identifying at least one software configuration corresponding to at least one of the first desired software configuration and the second desired software configuration, wherein the at least one software configuration is suitable for generating the first desired software configuration and the second desired software configuration, and	An image builder for identifying at least one software configuration corresponding to at least one of the first desired software configuration and the second desired software configuration, wherein the at least one software configuration is suitable for generating the first desired software configuration and the second desired software configuration, and
Storing the software configuration on a removable medium, the removable medium suitable for loading the first desired software configuration and the second desired software configuration.	An image server for storing the software configuration on a removable medium, the removable medium suitable for loading the first desired software configuration and the second desired software configuration.

The instant claim recites a system, including an order entry system, an image builder, and an image server corresponding to the patented method as set forth above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the patented method in a system for the purpose of enabling a computer to perform the steps of the patented method.

Per claim 34:

Patent 6,775,829	Instant Application
11. A computer implemented method of building a custom software configuration, comprising: Receiving a first request for a first desired software configuration and a second request for a second desired software configuration, the first desired software configuration being different than the second desired software configuration;	34. A system for building a custom software configuration, comprising: An order entry system receiving a first request for a first desired software configuration and a second request for a second desired software configuration, the first desired software configuration being different than the second desired software configuration;
Identifying at least one baseline configuration corresponding to at least one of the first desired software configuration and the second desired software configuration;	An image builder for identifying at least one baseline configuration corresponding to at least one of the first desired software configuration and the second desired software configuration;
Comparing the at least one baseline configuration with the first desired software configuration and the second desired software configuration	Comparing the at least one baseline configuration with the first desired software configuration and the second desired software configuration
Creating a set of changes based on the comparison wherein the set of changes are suitable for combining with the at least one baseline configuration to generate the first desired software configuration and the second desired software configuration, and	Creating a set of changes based on the comparison wherein the set of changes are suitable for combining with the at least one baseline configuration to generate the first desired software configuration and the second desired software configuration, and
Storing the at least one baseline configuration and set of changes on a removable medium, the removable medium suitable for loading the first desired software configuration and the second desired software configuration.	An image server for storing the at least one baseline configuration and set of changes on a removable medium, the removable medium suitable for loading the first desired software configuration and the second desired software configuration.

The instant claim recites a system, including an order entry system, an image builder, and an image server corresponding to the patented method as set forth above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the patented method in a system for the purpose of enabling a computer to perform the steps of the patented method.

Per claim 39:

Patent 6,775,829	Instant Application
16. A method of building a custom software configuration, comprising: Receiving a first customer order for a first information handling system and a second customer order for a second information handling system, the first customer order including a first list of hardware configuration components and a first list of software configuration components and the second customer order including second list of hardware configuration components and a second list of software configuration components, wherein at least one of the first list of hardware configuration components is different from the second list of hardware configuration components, and the first list of software configuration components is different from the second list of software configuration components; and	39. A system for building a custom software configuration, comprising: Means for receiving a first customer order for a first information handling system and a second customer order for a second information handling system, the first customer order including a first list of hardware configuration components and a first list of software configuration components and the second customer order including second list of hardware configuration components and a second list of software configuration components, wherein at least one of the first list of hardware configuration components is different from the second list of hardware configuration components, and the first list of software configuration components is different from the second list of software configuration components; and
Storing at least one software configuration on a removable medium, the at least one software configuration suitable for loading at least one of the first list of software configuration components and the second list of software configuration components onto at least one of the first information handling system and the second information handling system.	Means for storing at least one software configuration on a removable medium, the at least one software configuration suitable for loading at least one of the first list of software configuration components and the second list of software configuration components onto at least one of the first information handling system and the second information handling system.

The instant claim recites a system corresponding to the patented method as set forth above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the patented method in a system for the purpose of enabling a computer to perform the steps of the patented method.

Per claim 43:

Patent 6,775,829	Instant Application
21. A removable medium having machine readable instructions stored thereon for computer implemented execution, comprising: A software library, including:	43. A removable medium readable by an information handling system, comprising:
A first software configuration corresponding to a first customer order for a first information handling system, the first customer order including a first list of hardware configuration components and a first list of software configuration components, the first software configuration suitable for loading on the first information handling system; and	A first software configuration for loading on a first information handling system, the first software configuration corresponding to a first customer order for a first information handling system, the first customer order including a first list of hardware configuration components and a first list of software configuration components; and
A second software configuration corresponding to a second customer order for a second information handling system, the second customer order including a second list of hardware configuration components and a second list of software configuration components, the second software configuration suitable for loading on the second information handling system; and	A second software configuration corresponding to a second customer order for a second information handling system, the second customer order including a second list of hardware configuration components and a second list of software configuration components,
Wherein at least one of the first list of hardware configuration components is different from the second list of hardware configuration components and the first list of software configuration components is different from the second list of software configuration components so that the first software configuration is unsuitable for loading software configuration components on the second information handling system.	Wherein the first software configuration allows configuration of the first information handling system when loaded from the removable medium to the first information handling system and the second software configuration allows configuration of the second information handling system when loaded from the removable medium to the second information handling system, at least one of the first list of hardware configuration components being different from the second list of hardware configuration components and the first list of software configuration components being different from the second list of software configuration components so that the first software configuration is unsuitable for loading software configuration components on the second information handling system.

Claim 43 of the instant application is anticipated by claim 21 of Patent 6,775,829 in that claim 21 of the 6,775,829 patent contains all the limitations of claim 43 of the instant application. Claim 43 of the instant application therefore is not patentably distinct from the earlier patent claim and as such is unpatentable for obvious-type double patenting.

Per claims 25-28, 30-33, 35-38, 40-42, 44, 45 and 46:

10. Claims 25-28, 30-33, 35-38, 40-42, 44, 45 and 46 of the instant application are further anticipated by claims 2-5, 7-10, 12-15, 17-19, 22, 23 and 20, respectively, of U.S. Patent 6,775,829 in that claims 2-5, 7-10, 12-15, 17-19, 22, 23 and 20 of the 6,775,829 patent contains all the limitations of claims 25-28, 30-33, 35-38, 40-42, 44, 45 and 46, respectively, of the instant application. Claims 25-28, 30-33, 35-38, 40-42, 44, 45 and 46 of the instant application are therefore not patentably distinct from the earlier patent claims and as such are unpatentable for obvious-type double patenting.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on

the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trent J Roche whose telephone number is (703)305-4627. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (703)305-9662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Trent J Roche
Examiner
Art Unit 2124

TJR

Kakali Chaki
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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100